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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,882	11/16/2001	Gil Gavriel Dukiewicz	051448.0204	1063

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David A. Blumenthal
FOLEY & LARDNER
Suite 3500
2029 Century Park East
Los Angeles, CA 90067-3021

EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,882

Applicant(s)

DUKIEWICZ ET AL.

Examiner

Jason P Salce

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,17-51,54-62 and 65-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17-51,54-62 and 65-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-2, 5-14, 17-51, 54-62 and 65-71 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 5, 7-14, 17, 19-24, 47-51, 54-62 and 65-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henmi et al. (U.S. Patent No. 5,390,027) in view of Menard et al. (U.S. Patent No. 6,061,056).

Referring to claim 1, Henmi discloses receiving script data for a video program (see "VIDEO SIGNAL" entering "Data Extraction" unit 1 in Figure 1a). The video data containing video data, audio data and additional data transmitted specifically in the VBI portion of the video signal (Column 1, Lines 36-41 and Lines 61-63). Therefore any data contained in the VBI portion of the video signal can be considered script data.

Henmi also discloses determining identifiers of individual programming events within the program (see Column 6, Lines 32-36 for a program detector 115 in Figure 8 that extracts a program list data unit carrying program information of the television broadcasting).

Henmi also discloses producing closed caption data for the program, the closed caption data comprising text data corresponding to the script data (see Column 6, Lines 1-3 for extracting closed caption data (text data) from the VBI portion of a video signal (script data), also note that the program list data can be considered closed caption data (see reasons below)), and timing data provided at locations corresponding to the beginnings of each of the programming events (see Column 6, Lines 14-16 for processing the timing data contained in the data unit, which is from the script data transmitted in the VBI, also note that this timing data includes a start time as described in Figure 1b, which designates the beginnings of each programming event), the timing data corresponding to a programming event comprising an identifier of the corresponding programming event (see Column 8, Lines 6-18 for a description of how the timing data is stored in memory with the corresponding channel (identifier) of a program to be displayed in the program list). The examiner notes that closed caption data simply refers to text stored in the VBI of a broadcast stream, and that the program list data can also correspond to the closed caption data since this data can be displayed to a television screen and is stored in the VBI portion of a video signal.

Henmi fails to teach a production system used in production of the video program for sending the script data (data in the VBI). Henmi also only teaches receiving the script data for an entire program and not for "segments of the program". Menard teaches a production system (see element 38 in Figure 38 in Figure 8 for receiving programs from a satellite, and also Column 3, Lines 16-20 and Column 9, Lines 29-34). Menard also teaches that the script data (closed caption text in the VBI) is used to

receive specific segments of the programming (see Column 7, Lines 33-38). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the program closed caption decoding system, as taught by Henmi, to use the production system (closed captions sent over satellite) and the specific segment identifying means, as taught by Menard, for the purpose of allowing a user to only receive programming that he/she wishes to view (see Column 6, Lines 28-38 of Menard).

Claim 2 corresponds to claim 1, where Henmi discloses that the timing data also contains an end time (see Figure 1b).

Claim 5 corresponds to claim 1, where Henmi discloses providing synchronized transmission of the closed caption data and programming events (see "sync data" in Figure 2b and Column 1, Lines 36-45).

Claim 7 corresponds to claim 1, where Henmi discloses storing the programming events and the closed caption data on a storage medium (see Column 8, Lines 11-18 for storing programming events, such as recording a program and closed caption data (program table data)).

Claim 8 corresponds to claim 1, where Henmi discloses a recording reservation option (identifier), which determines an amount of time by which the identifier precedes the beginning of the programming event (see "Second Flag for Recording Reservation" in Figure 1b and Column 8, Lines 19-22). By using this identifier it is inherent that an amount of time is determined before the program will be recorded, otherwise the system cannot know when the program should be recorded.

Claim 9 corresponds to claim 1, where Henmi discloses that synchronization (timing) data is inserted before other data in the VBI (see Column 1, Lines 36-45).

Claim 10 corresponds to claim 1, where Henmi discloses that the text broadcast data is transmitted in the vertical blanking interval, which is hidden data in a video signal (Column 1, Lines 36-38).

Claim 11 corresponds to claim 1, where Henmi discloses that the timing data is accompanied by a timing data marker (see start or end time in Figure 1b).

Claim 12 corresponds to claim 1, where Henmi discloses that the timing data is encrypted (see Column 14, Lines 11-13 for disclosing an encoded (encrypted) transmission-format).

Referring to claims 13-14 and 17 and 19-24, see rejection of claims 1-2, 5 and 7-12, respectively.

Referring to claims 47, see rejection of claim 1 and note that closed caption data inherently follows the spoken words of the actor of the video program on a viewer's display.

Referring to claim 48, see rejection of claim 11.

Referring to claim 49, see rejection of claim 12.

Referring to claims 50-51, see rejection of claims 1-2 respectively. The examiner notes that "determining programming events within a program" and "determining identifiers of the programming events" are equivalent to the single limitation of "determining identifiers of individual programming events within the program".

Referring to claims 54 and 55, see rejection of claim 10.

Referring to claims 56-58, see rejection of claims 7-9, respectively.

Referring to claims 59-60, see rejection of claims 11-12, respectively.

Referring to claims 61-62 and 65-71, see rejection of claims 50-51 and 54-60, respectively.

3. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henmi et al. (U.S. Patent No. 5,390,027) in view of Menard et al. (U.S. Patent No. 6,061,056) in further view of Shriver (U.S. Patent No. 6,290,359).

Referring to claim 6, Henmi and Menard teach all the limitations in claims 1 and 5, and also teach a teleprompter (see display 3 in Figure 1 of Menard and element 122 of Figure 8 in Henmi). Both inventors fail to disclose that the teleprompter is used to a person who appears in a video program as a reader of the text (for example a newscaster or a person giving a speech at the academy awards using a teleprompter). Shriver teaches using a teleprompter to display to a person being filmed by a camera (therefore, being viewed by others on a television program) his/her script (see Column 7, Lines 21-31). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the displays of Menard and Henmi, using the teleprompter, as taught by Shriver, for the purpose of helping an actor or actress remember his/her lines for the play he/she is performing.

Referring to claim 18, see rejection of claim 6.

4. Claims 25-37 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Thong et al. (U.S. Patent No. 5,442,518) in view of Shriver (U.S. Patent No. 6,290,359).

Referring to claim 25, Van Thong discloses producing closed caption data (see Column 1, Lines 20-21). Van Thong also discloses that the closed caption data comprises timing data comprising beginning timing data provided at locations in the closed caption data corresponding to beginnings of programming events within the video program (see Column 1, Lines 46-48 for a time stamp defining when a caption should appear and disappear). Van Thong also discloses that the closed caption data discloses text data corresponding to at least an audio portion of the video program (see Column 1, Lines 9-15).

Van Thong also discloses producing a video signal for the video program (see use of pre-recorded movies or television programs at Column 1, Lines 28-30).

Van Thong also discloses synchronizing the closed caption data to the video signal in accordance with display of corresponding text by a teleprompter system used in the production of the video program (see Column 1, Lines 9-15 and Column 2, Lines 43-45). Also note that a teleprompter system is analogous to the display used to display the captions in relation to the spoken audio data being presented to a viewer.

Van Thong fails to teach that the teleprompter system is used by a person who appears in a video program as a reader of the text (for example a newscaster or a person giving a speech at the academy awards using a teleprompter). Shriver teaches using a teleprompter to display to a person being filmed by a camera (therefore, being viewed by others on a television program) his/her script (see Column 7, Lines 21-31). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the display of Van Thong, using the teleprompter, as taught by

Shriver, for the purpose of helping an actor or actress remember his/her lines for the play he/she is performing.

Claim 26 corresponds to claim 25, where Van Thong discloses that the timing data further comprises end-timing data provided at locations corresponding to ends of programming events (see Column 1, Lines 32-34 and Lines 46-48 on displaying a caption for a time period set by the start and end time of an actor speaking (programming event)).

Claim 27-28 corresponds to claim 25, where Van Thong discloses that the caption can be set for a segment of the video program where the actor is speaking (see Column 1, Lines 32-34).

Claim 29 corresponds to claim 25, where Van Thong discloses synchronizing video signal and closed caption data to the client video reception devices (see Column 1, Lines 5-15).

Claim 30 corresponds to claim 25, where Van Thong discloses storing the synchronized video signal and closed caption data on a machine-readable storage medium (see Column 1, Lines 49-51).

Claim 31 corresponds to claim 25, where Van Thong discloses that the timing data comprises an identifier associated with a programming event of the television program (see Column 1, 46-48 for the time stamp including an identifier (start of caption displaying) with is associated with a programming event).

Claim 32 corresponds to claim 25, see rejection of claim 31 and also notes Van Thong discloses data indicating an amount of time by which the identifier precedes the

beginning of the programming event (see Column 1, Lines 36-41 for a description of showing the caption before the actor starts speaking).

Claim 33 corresponds to claim 25, where Van Thong discloses that the timing data is inserted separately from the beginning of the programming event by using transcript data defining when a caption should be displayed (see Column 1, Lines 44-46).

Claim 34 corresponds to claim 25, where it is inherent that data in the closed caption portion of the video signal, which is the first 21 lines of the VBI, is hidden in the video signal (not displayed).

Claims 35-36 correspond to claim 25, where the examiner notes that the MPEP 2106 VI (Determine Whether the Claimed Invention Complies With 35 U.S.C. 102 and 103) states, "Nonfunctional descriptive material cannot render non-obvious an invention that would have otherwise been obvious." (Cf. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983). This section further states "a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e. the descriptive material does not reconfigure the computer). The teleprompter is shown to provide an actor or actress with his or her script lines. Simply because the actor appears in a news program, home shopping channel, or an academy award presenter, does not render the invention non-obvious, and therefore, does not distinguish the invention from the prior art in terms of patentability (see again MPEP 2106 IV) because the teleprompter system is still present, and providing the same function among all the different television programs.

Claim 37 corresponds to claim 25, where Van Thong discloses a time stamp for displaying a caption at the proper time (Column 1, Lines 46-48).

Referring to claims 39-45, see rejection of claims 25-37, respectively.

5. Claims 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Thong et al. (U.S. Patent No. 5,442,518) in view of Shriver (U.S. Patent No. 6,290,359) in further view of Brothers et al. (U.S. Patent No. 5,799,083).

Referring to claim 38, Van Thong and Shriver disclose all of the limitations in claim 25, but fail to teach that the timing data is encrypted. Brothers teaches the combined video and the closed caption data (all data in the VBI lines) are encrypted by encryption unit 24 (see Column 8, Lines 8-12). At the time invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the closed caption data (that includes a time stamp of when to display the closed caption on a teleprompter), as taught by Van Thong and Shriver, using the encryption unit 24, as taught by Brothers, for the purpose of allowing courts, intelligence agencies, new agencies, researchers, journalists, insurance agencies, and others to verify the authenticity of an electronic recording without having to further employ the services of a trusted third party 12 (see Column 8, Lines 36-41 of Brothers).

Referring to claim 46, see rejection of claim 38.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

November 14, 2003



VIVEK SRIVASTAVA
PRIMARY EXAMINER